REMARKS

In the Office Action mailed June 16, 2004, Claims 1-38 are held subject to a restriction requirement, the Examiner contending that the claims are directed to more than one invention as follows:

- Group I – Claims 1-25 and 32-38, which the Examiner contends are directed to a catalyst composition; and
- Group II - Claims 26-31, which the Examiner contends are directed to a process for making a polyol.

Applicant herein affirms the election made by the undersigned attorney to prosecute the claims of Group I (Claims 1-25 and 32-38), and therefore cancels Claims 26-31, but wishes to change the election from being made with traverse to being made without traverse. Applicant reserves the right to file one or more divisional applications directed to the non-elected subject matter.

Applicant confirms the substance of the Interview Summary form PTOL-413 provided with the instant Office Action regarding the interview conducted between Examiner Wood and the undersigned attorney.

In that same Office Action mailed June 16, 2004, Claims 1-25 and 32-38 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,477,589 issued to van der Hulst et al. Claims 1-5, 11, 18 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over an article entitled "Hexacyanometallate Salts Used as Alkene-Oxide Polymerization Catalysts and Molecular Sieves" by Kuyper et al. from the *Journal of Catalysis* **105**, 163-174 (1987).

Drawings

Applicant wish to point out that two (2) figures were filed with the instant application, but no Notice of Draftperson's Patent Drawing Review, form PTO-948, was received with the instant (first) Office Action. Applicant respectfully requests the Examiner advise as to whether the drawings are acceptable.

Rejections under 35 U.S.C. §103(a) over van der Hulst et al.

Claims 1-25 and 32-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,477,589 issued to van der Hulst et al. Applicant respectfully disagrees with the Examiner's contention regarding van der Hulst et al.

As stated in MPEP §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves of in the knowledge generally available to one of ordinary skill in the art, citing *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Clearly there is no such teaching, suggestion or motivation shown in the reference in this case. Applicant disputes the Examiner's statement at page 4 of the instant Office Action that,

> van der Hulst et al. discloses (*sic*) hydroxide containing DMC catalyst compositions. They are made by a method that appears closely analogous to that being employed by applicant. See particularly the examples.

What van der Hulst et al. teach is a hydroxide containing DMC intermediate that is nowhere stated to have any catalytic activity. In this regard, applicant respectfully directs the Examiner to page 4, line 15 of the instant specification which discusses van der Hulst and states that the hydroxide-containing intermediate is inactive. That the instantly claimed hydroxide-containing catalyst is active is amply demonstrated in Table III of the instant specification.

Further, the method of van der Hulst is not "closely analogous" to the instantly claimed method as alleged by the Examiner. The method of van der Hulst first makes an inactive hydroxide-containing intermediate of the general formula III (which is given at col. 4, line 8) and then reacts that inactive hydroxide-containing intermediate with "...more than the amount stoichiometrically required for converting the hydroxyl groups present of a compound H_nE_m ...preferably in the presence of water and/or an organic ligand L...." (col. 4, lines 12-16) to obtain an active catalyst. Compound H_nE_m is stated by van der Hulst, at col. 3, line 53, to be an acid.

In contradistinction, the instantly claimed process reacts a metal containing oxide with a metal containing hexacyanometallate or hexacyanometallic acid in the presence of an organic ligand, L, and water to directly obtain an active catalyst. The instantly claimed process retains the hydroxide rather than completely neutralizing it with acid as in van der Hulst. Thus, the teaching of van der Hulst et al. fails to suggest the instantly claimed invention.

Therefore, applicant contends that nothing in the teaching of van der Hulst et al. would lead one of ordinary skill in the art to the instantly claimed invention and respectfully requests the Examiner reconsider and reverse her rejection of Claims 1-25 and 32-38 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,477,589 issued to van der Hulst et al.

Rejections under 35 U.S.C. §103(a) over Kuyper et al.

Claims 1-5, 11, 18 and 25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over an article entitled "Hexacyanometallate Salts Used as Alkene-Oxide Polymerization Catalysts and Molecular Sieves" by Kuyper et al. from the *Journal of Catalysis* **105**, 163-174 (1987), hereinafter referred to as "Kuyper et al." Applicant respectfully disagrees with the Examiner's contention regarding Kuyper et al.

Kuyper et al., which is contemporaneous with van der Hulst also shares its deficiencies. Kuyper et al. do not teach a hydroxide-containing DMC catalyst as alleged by the Examiner at page 5 of the instant Office Action, but instead teach an inactive hydroxide-containing intermediate that must be further reacted to produce an active DMC catalyst. Applicant respectfully directs the Examiner's attention to page 163, second column, of Kuyper et al. wherein it is said of the 'basic' inactive hexacyanometallate salts,

> These turned out to be the preferred intermediates in the preparation of a catalyst.

Although these intermediates are said to have molecular sieving properties, nowhere in Kuyper et al. are these intermediates said to have any catalytic activity. Thus, Kuyper et al. fail to suggest the instantly claimed invention.

Therefore, applicant contends that nothing in the teaching of Kuyper et al. would lead one of ordinary skill in the art to the instantly claimed invention and

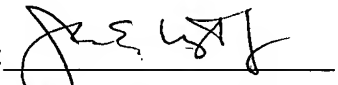
respectfully requests the Examiner reconsider and reverse her rejection of Claims 1-5, 11, 18 and 25 under 35 U.S.C. §103(a) as being unpatentable over an article entitled "Hexacyanometallate Salts Used as Alkene-Oxide Polymerization Catalysts and Molecular Sieves" by Kuyper et al. from the *Journal of Catalysis* **105**, 163-174 (1987).

Conclusion

Applicant has cancelled Claims 26-31. Such amendment is to be construed as "truly cosmetic" and is not believed to narrow the scope of the claims or raise an estoppel within the meaning of *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., et al.*, 535 U.S. 722 (2002). Applicant also contends that such claim amendments add no new matter and find support in the specification.

Applicant submits that the instant application is in condition for allowance. Accordingly, reconsideration and a Notice of Allowance are respectfully requested for Claims 1-25 and 32-38. If the Examiner is of the opinion that the instant application is in condition for other than allowance, she is invited to contact the applicant's Attorney at the telephone number listed below, so that additional changes to the claims may be discussed.

Respectfully submitted,

By: 

John E. Mrozinski, Jr.
Attorney for Applicant
Reg. No. 46,179

Bayer MaterialScience LLC
100 Bayer Road
Pittsburgh, PA 15205-9741
412-777-3024
FACSIMILE PHONE NUMBER:
412-777-3902
jdg/mrozinski/jem20